UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,355	08/14/2003	William E. Sobel	SYMAP024	1616

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EXAMINER
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ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/642,355	SOBEL, WILLIAM E.
	Examiner	**Art Unit**	
	Merilyn P. Nguyen	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-29* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-29* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *14 August 2003* is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a) ☐ All b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/31/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Detailed Action*.

DETAILED ACTION

1.   Claims 1-29 are pending in this application.

Acknowledges

2.   Receipt is acknowledged of the following items from the Applicant:

- Information Disclosure Statement (IDS) filed October 21, 2003 have been made

     of record. The references cited on the PTOL 1449 form have been considered.

Specification

3.   The disclosure is objected to because of the following informalities:

- The Summary of the Invention is missing at page 3.

- Appropriate correction is required.

Drawings

4.   Figure 1 should be designated by a legend such as --Prior Art-- because only that which is

old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR

1.121(d) are required in reply to the Office action to avoid abandonment of the application. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1, 3, 5, 9-12, 15, 24, 26-27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 15, and 26-27, there are no given steps to arrive the method for rolling back an image or rolling back a computer state.

Regarding claim 15, 27 and 29, these claims are being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: steps in the body of the claims are not cooperative related to each other.

Regarding claims 3 and 5, the terms "image is a system" and "image is an application" are inconsistent with its true meaning.

Regarding claim 9, "evaluating a definition" is vague and indefinite.

Regarding claims 9-12, there is insufficient antecedent basis for "a method as recited in claim 1 wherein securing the roll-back state" since there is no "securing the roll-back state" step in claim 1.

Regarding claim 24, this claim is being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary

structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships

are: devices/modules are not structural cooperative related to each other.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

6.   Claims 1-23 and 28-29 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of:

(1) whether the claim is directed to a judicial exception (law of nature, natural

phenomena, or an abstract idea) which would make it non-statutory if it is directed to the

exception itself, rather than a practical application of the exception. One way a practical

application can be established is through claiming a physical transformation (data transformation

is not a physical transformation and is not, in and of itself, evidence of statutory subject matter).

(2) Where there is no physical transformation being claimed, a practical application

would be established by a useful, concrete and tangible result. That result is useful if it has

specific, substantial and credible utility. Make a determination whether such is the case based on

the perspective of one of ordinary skill having read the claim in light of the disclosure. It's

concrete if it produces an assured, repeatable result (e.g., same input produces the same output

each time the steps are performed). For it to be a tangible result, it must be more than just a

thought or a computation. Instead, it must have real world value rather than being an abstract

result.

In the present case, claimed invention (Claims 1-23) merely recites the abstract idea of

method for rolling back an image that does not apply, involve, use or advance the technological

arts since all the recited steps can be performed in the mind of the user or by user of pencil and

paper.

In the present case, claimed invention (Claims 28 and 29) does not produce tangible

result since it includes **intangible media** such as **signals**, **carrier waves**, transmissions, optical

waves, transmission media or other media incapable of being touched or perceived absent the

tangible medium through which they are conveyed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1-16 and 19-29 are rejected under 35 U.S.C. 102(e) as being anticipated by

Humlicek (U.S. Patent No. 6,594,744).

Regarding claims 1, 2, 26 and 28, Humlicek discloses a method, a computer program

product for rolling back an image (See col. 8, line 1-59) comprising:

- determining a roll-back state (See col. 8, lines 5-7);

- configuring a current state to the roll-back state (See col. 8, lines 8-9); and

- determining whether the roll-back state is secure (See col. 8, lines 23-37).

Humlicek further discloses securing the roll-back state (See col. 8, lines 23-37) as per claim 2, 26

and 28.

Regarding claims 3-5, Humlicek discloses wherein the image is a system, a file or an

application (See Fig. 2-5).

Regarding claim 6, Humlicek discloses wherein determining a roll-back state includes

determining a non-infected state (See col. 8, lines 1-28).

Regarding claim 7, Humlicek discloses wherein configuring a current state to the roll-

back state includes marking a first portion of a repository (See col. 8, lines 9-13 and col. 11, lines

2-7).

Regarding claim 8, Humlicek discloses wherein configuring a current state to the roll-

back state further includes reverting a second portion of the repository (See col. 8, lines 33-38,

and col. 11, lines 11-40).

Regarding claim 9, Humlicek discloses wherein securing the roll-back state further

includes evaluating a definition in a repository providing data to the roll-back state (See col. 8,

lines 29-33 and col. 11, lines 1-28).

Regarding claim 10, Humlicek discloses wherein securing the roll-back state further

includes determining whether the definition is updated (See col. 8, lines 29-33 and col. 11, lines

21-41).

Regarding claim 11, Humlicek discloses wherein securing the roll-back state further

includes retrieving an updated definition if the definition is not updated (See col. 8, lines 29-33

and col. 11, lines 20-28).

Regarding claim 12, Humlicek discloses wherein securing the roll-back state further

includes installing the updated definition if the definition is not updated (See col. 8, lines 29-56).

Regarding claim 13, Humlicek discloses wherein configuring a current state to the roll

back state further includes displaying a message (See col. 5, lines 26-28 and col. 6, lines 50- 61)

and receiving a user input (See col. 6, lines 12-16).

Regarding claim 14, Humlicek discloses wherein configuring a current state to the roll-

back state further includes using the user input to determine the roll-back state (See col. 10, line

66 to col. 11, line 7).

Regarding claims 15, 27 and 29, Humlicek discloses a method for rolling back a

computer state comprising:

- scanning a repository (See col. 25, lines 40-55);

- leaving a marker in a first portion of the repository (See col. 11, lines 1-5);

- determining a safe state (See col. 11, lines 1-2);

- reverting the computer state to the safe state (See col. 10, line 67 to col. 11, line 2); and

- analyzing a second portion of the repository determined by the marker and the safe state (See col. 11, lines 20-28).

Regarding claim 16, Humlicek discloses wherein scanning the repository further comprises:

determining a version (See col. 8, lines 10-22 and col. 11, lines 2-5); and

updating the version if the version occurred prior to leaving the marker in the first portion of the repository (See col. 8, lines 29-33).

Regarding claims 19-21, Humlicek discloses wherein reverting the computer state to a safe state includes restoring a system/file/application to a previously non-infected version of the system/file/application (See col. 8, lines 1-28).

Regarding claim 22, Humlicek discloses wherein the first portion of the repository is non-revertible (See col. 11, lines 10-11).

Regarding claim 23, Humlicek discloses wherein the second portion of the repository is revertible (See col. 11, lines 1-6).

Regarding claim 24, Humlicek discloses a system for rolling back an image comprising:

a repository for storing data (See Fig. 2);

a scanner for determining a roll-back state (host devices 104, 106 for example, Fig. 1);

a protection module for configuring a current state to the roll-back state (volume manage

144, Fig. 2); and

a definition for securing the roll-back state (See col. 8, lines 29-38).

Regarding claim 25, Humlicek discloses a first portion of non-revertible memory for

storing a marker; and a second portion of revertible memory for storing data related to the roll-

back state. See Figs. 9-11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humlicek

(U.S. Patent No. 6,594,744), in view of Liang (US 2003/0115483).

Regarding claim 17, Humlicek discloses all the claimed subject matter as set forth above

in claim 15. However, Humlicek is silent as to wherein determining a safe state includes

searching for a virus. On the other hand, Liang teaches determining a safe state includes

searching for a virus (See Fig. 5 and corresponding text, and paragraph [0026], Liang et al.). It

would have been obvious to one having ordinary skill in the art at the time of the invention was

made to searching for a virus as suggested by Liang. The motivation would have been to

securing the Humlicek system by finding and killing the virus so that images files free of

infections.

Regarding claim 18, Humlicek discloses all the claimed subject matter as set forth above

in claim 15. However, Humlicek is silent as to evaluating a result of a vulnerability assessment.

On the other hand, Liang teaches evaluating a result of a vulnerability assessment (See paragraph

[0052], Liang et al.). It would have been obvious to one having ordinary skill in the art at the

time of the invention was made to evaluating a result of a vulnerability assessment. The

motivation would have been to prevent the recurrence of virus spreading.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Watts U.S Patent No. 6,336,161 discloses computer configuration system and method

with state and restoration from non-volatile semiconductor memory.

Stegelmann U.S Patent No. 6,772,155 discloses looking data in a database system.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026.

The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the

organization where this application or proceeding is assigned are 571-273-8300 for regular

communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

MN
February 16, 2006

FRANTZ COBY
PRIMARY EXAMINER